

claims would be allowable if rewritten to include the features of their base claims and any intervening claims.

With respect to paragraph one (1) of the Office Action, a new declaration is not necessary. Contrary to the Examiner's assertion, there is no requirement that an oath or declaration identify which inventor is the "first" or "second" inventor. The filed declaration clearly identified the joint inventors, and no further information is necessary.

With respect to paragraph two (2), Applicants are tendering a corrected drawing to address the Examiner's concerns regarding the labeling of Figure 1.

With respect to paragraph three (3), Applicants tender a new title, "METHOD AND DEVICE FOR CONTROLLING VEHICLE SPEED" in response to the Examiner's request.

With respect to paragraph five (5), the Examiner rejected claims 1 and 2 under 35 U.S.C. § 102(b) as anticipated by Sigl, U.S. Patent No. 5,594,735.

With respect to paragraph seven (7), claim 8 was rejected under 35 U.S.C. § 103(a) as unpatentable over Sigl, U.S. Patent No. 5,594,735.

**The 35 U.S.C. § 102(b) rejection should be withdrawn**

The Examiner has rejected claims 1 and 2 under 35 U.S.C. § 102(b) as being anticipated by Sigl, U.S. Patent No. 5,594,735. ("Sigl"). However, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim limitation is identically disclosed in a single prior art reference. (See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). "The identical invention must be shown in as complete detail as is contained in the claim." M.P.E.P. § 2131. For the reasons that follow, the rejection of independent claim 1 should be withdrawn. Because claim 2 depends from base claim 1, it too is allowable and the rejection thereof should also be withdrawn.

The rejection of independent claim 1 should be withdrawn because Sigl does not disclose each and every claim limitation of claim 1 identically. Claim 1 recites "[a] method for controlling a vehicle comprising the steps of . . . detecting whether the vehicle is traveling on a descent." Sigl, however, does not teach this step of "detecting whether the vehicle is traveling on a descent." Rather, Sigl discloses how to achieve a desired driving speed through checking the tractive resistance torque. Col. 4, ll. 64-67. According to Sigl,

“[w]hen driving on a downhill grade, the driver specifies a lower setpoint speed. In this case, the actual speed is likewise greater than the setpoint speed. It must be checked whether just taking away the engine torque will suffice to achieve a deceleration. . . Instead of the throttle-valve position, one can use other load signals, such as the injected fuel quantity, or in the case of diesel gasoline engines, for example, the control rod position.” Col. 5, ll. 5-20. Sigl simply does not detect whether the vehicle is traveling on a descent.

As noted above, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim limitation is identically disclosed in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Moreover, as the M.P.E.P. makes clear, “[t]he identical invention must be shown in as complete detail as is contained in the claim.” M.P.E.P. § 2131. Sigl does not identically disclose the features of the present invention in as complete detail as is contained in claim 1.

To the extent that the Office Action relies on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’l. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art (which has not been asserted in the present case) does not establish the inherency of that result or characteristic.

Accordingly, it is respectfully submitted that Sigl cannot and does not anticipate claim 1 for the foregoing reasons, and it is therefore respectfully submitted that claim 1 is allowable.

Because claims 2 depends from claim 1, that claim is allowable for the same reasons that claim 1 is allowable.

**The 35 U.S.C. § 103(a) rejection should be withdrawn**

The Examiner has rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Sigl. However, “[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” M.P.E.P. § 2143.03. “Each reference must qualify as prior art under 35 U.S.C. 102.” M.P.E.P. § 2144.08, Part II.A.1. “It is essential that office personnel find some motivation or suggestion

to make the claimed invention in light of the prior art teachings.” M.P.E.P. § 2144.08, Part II.A. For the reasons that follow, the rejection of claim 8 should be withdrawn.

Sigl does not disclose or suggest all the limitations of claim 8, and therefore cannot be an invalidating reference under 35 U.S.C. § 103(a). Moreover, the Office has not put forth any motivation to make the invention claimed in claim 8 based on the teachings of the applied reference. As a result, the Office has not established *prima facie* obviousness with respect to claim 8. Claim 8 recites “an output arrangement via which a manipulated variable that influences the actual speed of the vehicle is output based on the actual speed and the setpoint speed in order to influence the actual speed of the vehicle, wherein: the control device includes an enabling arrangement for enabling only the manipulated variable to be calculated and output, respectively, if a descent of the vehicle has been detected.”

Sigl, however, does not teach outputting a “manipulated variable” that influences the actual speed of the vehicle. Rather, Sigl teaches the outputting of a “trigger signal” for the final controlling element which influences power output within the vehicle. Col. 2, ll. 64-67. Sigl does not suggest or provide any motivation to output a “manipulated variable.” Moreover, the “trigger signal” in Sigl is not “based on the actual speed and the setpoint speed,” but rather depends on “the actuation of the gas pedal by the driver and, in some instances, upon the performance quantities detected by the measuring devices 20 through 22, such as throttle-valve position, engine temperature, engine rpm, driving speed, etc.” Col. 2, ll. 60-64. Sigl does not suggest or provide any motivation for one to base a signal on the actual speed and the setpoint speed.” Because Sigl does not disclose or suggest all the limitations of claim 8, the Office has not established *prima facie* obviousness with respect to claim 8.

Accordingly, it is respectfully submitted that the Sigl reference cannot and does not anticipate claim 8 for the foregoing reasons, and it is therefore respectfully submitted that claim 8 is allowable.



CONCLUSION

In view of all of the above, it is believed that the rejections of claims 1, 2, and 8 have been obviated, and that all of claims 1 to 9 are allowable. It is therefore respectfully requested that the rejections be withdrawn and that the present application issue as early as possible.

Respectfully submitted,

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**Marked-Up Version of Amendment Showing Changes Made**

**In the Title:**

The title has been amended as follows:

-- METHOD AND DEVICE FOR CONTROLLING VEHICLE SPEED --